

REMARKS

This is in response to the Office Action that was mailed on March 13, 2006. Claim 1 is cancelled, without prejudice. The recitations of claim 3 are incorporated into claim 2, and claim 3 is accordingly cancelled, without prejudice. Claim 5 is rewritten in independent form. The dependency of claim 16 is changed, based upon the preceding amendments. No new matter is introduced into this application. Claims 2 and 4-16 are pending in the application, of which claims 6-15 are withdrawn from consideration on their merits.

Issue under 35 U.S.C. §112

Claims 1, 2, and 16 were rejected under 35 U.S.C. §112, first paragraph, as failing to recite essential elements of the composition being claimed. Claim 3 – properly – was not rejected on this ground. Claim 1 has been cancelled, claim 2 has been amended to recite the compositional features of non-rejected claim 3, and claim 16 has been amended to depend from claim 2. It is respectfully submitted that these amendments overcome the rejection under 35 U.S.C. §112, first paragraph.

Issue under 35 U.S.C. §103(a)

Claims 1-5 and 16 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Publication 2005/0095527A1 (Yokoyama). The Yokoyama application was filed in the U.S. on 7 October 2003. The present application claims priority to an application filed in Japan on 21 May 2003. Enclosed herewith is a verified translation into the English language of a certified copy of Applicants' priority document. It is respectfully submitted that the Yokoyama

publication is antedated, and that it therefore may no longer be applied as a reference against the present application.

Issues under 35 U.S.C. §102(e)

Claims 1-4 and 16 were rejected under 35 U.S.C. §102(b) as being anticipated by US 6,770,419 B2 (Khojasteh). Khojasteh discloses 1-t-butyloxycarbonyl-2-phenylbenzimidazole. The closest compound embraced by current independent claim 2 involves formula (3) in claim 2. As the Examiner will note, while Khojasteh requires a carbonyl group directly attached to a nitrogen atom in the benzimidazole ring (a sort of amide), formula (3) always requires an alkylene linkage between the carbonyl group and the ring nitrogen atom (not an amide linkage). The Khojasteh disclosure fails to suggest a positive-working resist composition comprising: (A) at least one basic compound having a benzimidazole skeleton and a polar functional group, as represented by formula (3) in claim 2; (B) an organic solvent; (C) a base resin having an acid labile group-protected acidic functional group which is alkali-insoluble or substantially alkali-insoluble, but becomes alkali-soluble when the acid labile group is eliminated; and (D) a photoacid generator. Withdrawal of the rejection over Khojasteh is earnestly solicited.

Claims 1-4 and 16 were rejected under 35 U.S.C. §102(b) as being anticipated by US 6,361,920 B1 (Loccufier). The Examiner had indicated that this rejection was based upon an interpretation of the claims as being drawn to compounds as such (and not to resist compositions). It is respectfully submitted that the Loccufier disclosure fails to suggest a positive-working resist composition comprising: (A) at least one basic compound having a benzimidazole skeleton and a polar functional group, as defined in present claim 2; (B) an

organic solvent; (C) a base resin having an acid labile group-protected acidic functional group which is alkali-insoluble or substantially alkali-insoluble, but becomes alkali-soluble when the acid labile group is eliminated; and (D) a photoacid generator. Withdrawal of the rejection over the Loccufier reference is earnestly solicited.

If the Examiner has any questions, he is invited to contact Richard Gallagher, Registration No. 28,781, at (703) 205-8008.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

By  # 28,781

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